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IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSINJUN -7 PM 3:53
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CLERK US DIST COURT
WD OF WI

SYMBOL TECHNOLOGIES, INC.,

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Plaintiff,

v.

05-C-0256 C

INTERMEC TECHNOLOGIES CORP.,

Defendant.

**SYMBOL TECHNOLOGIES, INC.'S MOTION FOR LEAVE TO FILE A SUR-REPLY
DECLARATION IN RESPONSE TO THE REPLY BRIEF OF INTERMEC
TECHNOLOGIES CORPORATION IN SUPPORT OF ITS MOTION TO TRANSFER**

Plaintiff Symbol Technologies, Inc. ("Symbol"), through its undersigned counsel, hereby moves the Court for leave to file the attached Declaration of Aaron B. Bernstein in Further Opposition to Intermec Technologies Corporation's Motion to Transfer ("Bernstein Declaration"). This response is necessary to rebut and correct statements made for the first time in Intermec's reply memorandum, dated June 3, 2005, in support of its motion under 28 U.S.C. § 1404(a) to transfer this action to the District of Delaware or in the alternative, to the District of Washington ("Intermec Reply").

Intermec contends for the first time in its reply that (1) it has a license under an OEM agreement previously in place between the parties ("OEM Agreement") which immunizes Intermec products incorporating scan engines made by Symbol from claims of patent infringement in this case and in Delaware, thereby purportedly presenting common issues for determination in both actions; and (2) a forum selection clause in the OEM Agreement requires

that determination of that alleged licensing dispute be venued in Delaware. (Intermec Reply, pp. 3, 8, 10-11.)

Mr. Bernstein's Declaration is needed solely to make it clear that Symbol is not suing Intermec in this case on Intermec products which use scan engines purchased from Symbol under the OEM Agreement. This is significant because, contrary to Intermec's new argument, (1) there is, in fact, no dispute in this action as to the scope of Intermec's license under the OEM Agreement (and therefore no common license-related issue between this action and the Delaware litigation); and (2) absent any such dispute the OEM Agreement's Delaware forum selection clause is irrelevant to this action and Intermec's effort to transfer to Delaware.

WHEREFORE, Symbol respectfully requests permission to file the Bernstein Declaration in further opposition to Intermec's motion to transfer.

Respectfully submitted,

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Dated: June 7, 2005

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UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WISCONSIN

2000

3:53

SYMBOL TECHNOLOGIES, INC.,

THEODORE J. CIVENS
CLERK US DIST COURT
WD OF WI

Plaintiff,

v.

Case No. 05-C-0256-C

Hon. Barbara B. Crabb

IMTERMEC TECHNOLOGIES, INC.,

Defendant.

CERTIFICATE OF SERVICE

I, Shane A. Brunner, hereby certify that on June 7, 2005, I caused true and correct copies of: (1) Symbol Technologies, Inc.'s Motion for Leave to File a Sur-Reply Declaration in Response to the Reply Brief of Intermec Technologies Corporation in Support of its Motion to Transfer; (2) Declaration of Aaron B. Bernstein in Further Opposition to Intermec Technologies Corporation's Motion to Transfer to be served via the following method:

VIA E-MAIL and VIA MESSENGER

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